

RECEIVED
CENTRAL FAX CENTER

SEP 14 2004

**FAX COVER SHEET**

LSI LOGIC CORPORATION
Office of General Counsel
1621 Barber Lane
M/S D-106
Milpitas, CA 95035
Fax: (408) 433-7460

Date: September 14, 2004
To Name: USPTO – Box: Amendment
Fax: (703) 872-9306
Phone: (703) 305-8283

From: Name: Manu Kashyap, Intellectual Property Paralegal
Corporate Legal Dept.
Telephone: (408) 433-7475
Fax: (408) 433-7460

Re: 09/991,202

Number of Pages Including this Page 4

This facsimile transmission is intended for the addressee indicated above. It may contain information that is privileged, confidential or otherwise protected from disclosure. Any review, dissemination or use of this transmission or its contents by persons other than the addressee is strictly prohibited. If you have received this transmission in error, please notify us immediately by telephone, and mail the original to us at the above address.

MESSAGE:

US Serial No.: 09/991,202
Filing Date: November 21, 2001
Group Art Unit: 2812
Docket No: 01-555
Examiner: Stanetta D. Isaac
Response to Restriction Requirement

Please notify us immediately if any pages are not received.


PTO/58/21 (02-04)

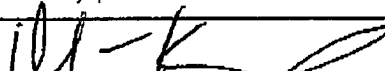
Approved for use through 07/31/2008. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/991.202	
	Filing Date	November 21, 2001	
	First Named Inventor	Venkatesh P. Gopinath, et al.	
	Art Unit	2812	
	Examiner Name	Stanetta D. Isaac	
Total Number of Pages in This Submission	3	Attorney Docket Number	01-555

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD. Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks Response to Restriction Requirement		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual name	Timothy R. Croll 36,771 (408) 433-7625	
Signature		
Date	September 14, 2004	

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.		
Typed or printed name	Manu Kashyap	
Signature		Date 09/14/2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED
CENTRAL FAX CENTER
SEP 14 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Venkatesh P.)
Gopinath, et al.) Group Art Unit: 2812
)
) Examiner: Stanetta D. Isaac
Serial No.: 09/991,202)
) Atty. Docket No.: 01-555
Filed: November 21, 2001)
)
For: Shallow Trench Isolation Structure)
With Low Trench Parasitic Capacitance)
)

RESPONSE TO OFFICIAL ACTION
Restriction/Election Requirement

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This response is presented to the Office Action mailed August 25, 2004, wherein the Examiner required restriction pursuant to 35 U.S.C. §121. Election is hereby made, *with traverse*, to prosecute Group I, method claims 1-26.

Remarks/Arguments

Reconsideration of the restriction is respectfully requested. Restriction is not required by 35 U.S.C. §121, as suggested in the Office Action. Congress wisely granted the *discretion* to restrict applications. According to 35 U.S.C. §121 "... the Commissioner *may* require the application to be restricted...." (emphasis added).

Furthermore, MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The inventions must be independent or distinct as claimed; and
- 2) There must be a serious burden on the examiner if restriction is required.

In searching the Group I claims, the class and subclass for the Group II claims will undoubtedly be searched, to ensure that no relevant art is overlooked. For this reason there is no significant burden on the examiner, and certainly no serious burden as required by MPEP §121.

In fact, maintaining the requirement for restriction not only burdens applicants with the additional costs associated with filing and prosecuting separate patent

applications, but also requires the examiner to duplicate efforts by examining multiple applications of closely related inventions. Such practice not only wastes public and private funds and Patent Office resources, but also leads to the possibility of inconsistent examinations of closely related inventions. Accordingly, applicants respectfully request that the examiner reconsider and withdraw the restriction requirement.

In light of the foregoing, applicants respectfully submit that a full and complete response to the Office Action is provided herein, and request that the application proceed to examination.

In the event this response is not timely filed, applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to deposit account 12-2252.

Respectfully Submitted,



Timothy R. Croll
Reg. No. 36,771
(408) 433-7625
LSI LOGIC CORPORATION
1621 Barber Lane
M/S D-106
Milpitas, CA 95035-7451

Date: September 13, 2004